



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/798,551

03/12/2004

James J. Darr

20874.101C1US

6462

41434

7590

06/09/2009

PATTON BOGGS LLP

2550 M STREET NW

WASHINGTON, DC 20037-1350

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

06/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

In response to the restriction requirement, mailed 02/02/09, after non-final rejection, the applicant has elected the invention of group I (claims 1-8 and 12-24) without traverse. Applicant's election of Group I is hereby acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 3696

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 12-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-39, and 41-102 of copending Application No. 10382947. For example, claim 1 of copending application recites a system for raising funds for a first organization comprising: a memory for storing executable instructions, and a processor for performing the steps comprising: identifying one or more individuals associated with the first organization; requesting enrollment of the one or more identified individuals in a program permitting the first organization to take out one or more insurance policies on a life of each of the one or more identified individuals naming the first organization as beneficiary, and granting the first organization an irrevocable right to utilize the one or more insurance policies on a life of each of the one or more identified individuals to serve the best interests of the first organization; receiving information from one or more of the identified individuals accepting the enrollment; selecting one or more of the one or more enrolled individuals based upon the received information to create a structured final asset comprising one or more insurance policies for each of the selected individuals, wherein the one or more insurance policies are selectively grouped based upon

Art Unit: 3696

actuarial matrices or formulas into the structured financial asset; facilitating payment of premiums for the structured financial asset, naming the first organization as beneficiary of the structured asset; transferring, partially, exclusively or wholly, one or more rights and/or benefits from the structured financial asset to at least a second organization to raise funds for at least one of (i) the first organization and (ii) the second organization and wherein the structured financial asset generates a variable net cash flow after the payment of premiums, based upon and timed by actual mortality payment and not based upon and timed by an expected mortality rate. Similarly, claims 2-4, 6-39, and 41-102 of copending Application No. 10382947 recites substantially the same limitations as claim 2-8, and 12-24 of the pending applicant with slight changes and variations that would have been obvious to one of ordinary skill in the art. This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3696

Claims 1-5, 7-8, 12-20, and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Herman (US PUB NO.: 2002/0035489).

Re claim 1. Herman discloses a method for raising funds for a first organization comprising: identifying one or more individuals associated with the first organization (see paras 0008); requesting enrollment of the one or more identified individuals in a program permitting the first organization to take out an insurance policy on each life of the one or more identified individuals naming the first organization as beneficiary (see paras 0022), and granting the first organization an irrevocable right to utilize the insurance policy on each life of the one or more identified individuals to serve the best interests of the first organization (see paras 0007 and 0024); receiving information from one or more of the identified individuals accepting the enrollment; selecting one or more of the one or more enrolled individuals based upon the received information to create a financial instrument comprising one or more insurance policies for each of the selected individuals (see paras 0008), wherein the one or more insurance policies are selectively grouped based upon actuarial matrices or formulas into the financial instrument (see paras 0024); facilitating payment of premiums for the financial instrument (see paras 0009); holding a financial instrument of a first organization in a passive vehicle (i.e., escrow account, see fig.4 element 420); providing, by a second organization, capital to the first organization (i.e., lenders provide loans, see paras 0008) as evidenced by a promissory note secured by the financial instrument; transferring a right or a benefit that the passive vehicle receives with respect to the financial instrument as repayment of the promissory note (i.e., The insurance policies serve as collateral to the lender for

Art Unit: 3696

the loan. The insurance premiums are invested in traditional securities to generate an investment return, so that the cash value associated with the policies increases with time. A predetermined cash flow is guaranteed to the foundation by the program, as a function of the number of lives insured, for example. Loan payments are made to the lender from the life insurance policy death benefit proceeds and, as needed, from guaranteed mortality reinsurance payments, see paras 0009), and wherein the financial instrument generates a variable net cash flow after the payment of premiums determined by factors selected from the group consisting of ages of the selected individuals, mortality rate of the selected individuals, investment performance of the financial instrument, guarantees of an insurance company, and combinations thereof (see paras 0009) (see the summary of the invention, also see the abstract).

Re claim 2. Herman further discloses the method of claim 1, wherein the passive vehicle holds the financial instrument on behalf of the first organization and the second organization (i.e., escrow account, see fig.4 element 420)

Re claim 3. Herman further discloses the method of claim 1, wherein the right or the benefit includes canceling the financial instrument (i.e., terminate said reinsurance policy, see col.32, line 28-30)

Re claim 4. Herman further discloses the method of claim 1, wherein the right or the benefit includes distributing all assets contained within the passive vehicle (see paras 0010)

Re claim 5. Herman further discloses the method of claim 1, wherein the right or the benefit includes transferring a right or a benefit from the financial instrument at any time

Art Unit: 3696

(see paras 0010)

Re claim 7. Herman further discloses the method of claim 1, wherein the first organization is a non-profit organization (see the abstract)

Re claim 8. Herman further discloses the method of claim 1, wherein the second organization includes a lender. (see fig.1 element 108)

Re claim 12. Herman further discloses the method of claim 1, wherein the first organization is solely responsible for the premiums of the one or more insurance policies (see the summary of the invention)

Re claim 13. Herman further discloses the method of claim 1, wherein the one or more insurance policies is structured as a single premium modified endowment contract (see paras 0034)

Re claim 14. Herman further discloses the method of claim 1, wherein the financial instrument includes variable universal life insurance (see paras 0031 and 0034).

Re claim 15. Herman further disclose the method of claim 1, wherein the passive vehicle includes a trust (see paras 0010)

Re claim 16. Herman further discloses the method of claim 1, wherein the passive vehicle includes a Qualifying Special Purpose Entity (see fig1 element 110)

Re claim 17. Herman further discloses the method of claim 1, wherein the second organization, upon the transfer of the financial instrument by the first organization to the passive vehicle, has an investment classified as an "available for sale investment" under FASB 140 at the full purchase price of the second organization (see paras 0035)

Re claim 18. Herman further discloses a method for raising funds for a first organization

Art Unit: 3696

comprising: identifying insurable interests associated with the first organization (see paras 0008); requesting authorization for the first organization to insure the insurable interests; taking out one or more policies insuring the insurable interests, wherein the insurable interests are the lives of a plurality of individuals associated with a non-profit organization (see paras 0022); naming the first organization as the beneficiary of the one or more policies (see paras 0007 and 0024); selectively grouping the one or more policies based upon actuarial matrices and formulas (see paras 0024), transferring funds as evidenced by a promissory note secured by each grouping of the one or more policies to the first organization (see paras 0008-0009); and repaying the promissory note by transferring one or more benefits or rights from the one or more policies (i.e., Loan payments are made to the lender from the life insurance policy death benefit proceeds and, as needed, from guaranteed mortality reinsurance payments, see paras 0009), wherein the selective grouping of the one or more generates a variable net cash flow after the payment of premiums determined by factors selected from the group consisting of ages of the selected individuals, mortality rate of the selected individuals, investment performance of the financial instrument, guarantees of an insurance company, and combinations thereof (see paras 0009) (see the summary of the invention, also see the abstract).

Re claim 19. Claim 19 recites similar limitations to claim 18 and thus rejected using the same art and rationale as in claim 18 *supra*.

Art Unit: 3696

Re claim 20. Claim 20 recites similar limitations to claim 1 and thus rejected using the same art and rationale as in claim 1 supra.

Re claim 22. Herman further discloses the method of claim 20, wherein the first organization is solely responsible for the premiums of the financial instrument (see the summary of the invention).

Re claim 23. Herman further discloses the method of claim 20, wherein the passive vehicle is a Qualifying Special Purpose Entity (see fig1 element 110)

Re claim 24. Herman further discloses the method of claim 20, wherein the second organization, upon the transfer of the financial instrument by the first organization to the passive vehicle, has an investment classified as an "available for sale investment" under FASB 140 (see paras 0035).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3696

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman.

Re claims 6 and 21. Herman does not explicitly disclose the method of claim 1, wherein the right or the benefit includes a call option to acquire the financial instrument from the passive vehicle. However, official notice is taken that option trading is old and well known in the investment world. Thus one of ordinary skill in the art would have been motivated to go into an agreement to buy the financial instrument at a specified price within a specified time for higher potential return.

Response to Arguments

Applicant's arguments filed 06/26/08 have been fully considered but they are not persuasive. The applicant argues that Herman fails to teach a variable net cash flow based upon and timed by actual mortality payments as claimed. Contrary to the applicant's assertion, Herman discloses a variable net cash flow based upon and timed by actual mortality payments (i.e., a predetermined cash flow is guaranteed to the foundation by the program, as a function of the number of lives insured, for example. Loan payments are made to the lender from the life insurance policy death benefit proceeds and, as needed, from guaranteed mortality reinsurance payments. A trustee holds the insurance policies on behalf of the foundation and files death benefit (or life insurance policy) claims. A re-insurer issues the mortality guarantee reinsurance policy to compensate for any shortfalls in death benefit pay-outs from the insurer, thereby protecting the lender by ensuring a minimum level of overall insurance proceeds. The

Art Unit: 3696

re-insurance policy acts as collateral for the loan, so need only be in effect until the lender is paid in full. However, the foundation may choose to continue the reinsurance policy even after the obligations to the lender have been satisfied, see paras 0009).

The applicant further argues that Herman fails to disclose selectively grouping one or more insurance policies based upon actuarial matrices or formulas. Contrary to the applicant's assertion, Herman explicitly discloses "selectively grouping one or more insurance policies based upon actuarial matrices or formulas." (i.e., a block of individuals is defined by (or on behalf of) Foundation 102. In the preferred form, each individual in the block of individuals assents to have a life insurance policy taken out in his or her name for the benefit of Foundation 102. Preferably, Foundation 102 is at least a 90% named beneficiary with the individual naming the beneficiary of the remaining 0-10%, for example. In some embodiments, the Foundation 102 may be the only named beneficiary, and in other embodiments Foundation 102 may be less than a 90% beneficiary. In the preferred form, the block of individuals includes at least 5,000 individuals within the age range of 25 years old to 70 years old. Smaller or larger blocks of individuals may also be defined, so long as the block of individuals provides acceptable risk reward for the various entities involved, and sufficient proceeds to fund Foundation 102's mission statement, see pars 0024 of Herman). The examiner contends that defining a block of individuals to have a life insurance policy taken out in his or her name for the benefit of Foundation 102 is akin to selectively grouping one or more insurance policies based upon actuarial matrices, as taught by the applicant

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Primary Examiner, Art Unit 3696